

## **REMARKS**

### **Introduction**

Examiner Trettel is thanked for the courtesies extended to the undersigned during the telephone interview on August 23, 2003. Claims 27, 29-47 and 58-70 are solicited. Claims 27, 31, 32, 36-39 and 45 are presented in independent form. The following remarks reflect and expand upon the subject matter discussed during the telephone interview.

### **Claim Rejections**

Claims 38 and 65-69 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,175,897 to Marra, Jr. ("Marra") in view of U.S. Patent No. 5,542,138 to Williams et al. ("Williams"). Claims 38, 40-44, 65, 68 and 69 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,612,679 to Mitchell ("Mitchell") in view of Williams.

Marra relates to a bed rail cover system including a pair of bed rails 14, 16 that are connected to the bed frame 12 by connector elements 18. Connector elements 18 allow movement of the rails between a raised and lowered position. Two housings 32, 34 are positioned on the rails for accommodating equipment such as controls for adjusting the configuration of the bed or a communication apparatus such as a telephone or intercom.

Mitchell relates to a side guard assembly including a side guard assembly 40 supported by two swing arms 72. The side guard assembly 40 includes a bed control unit 160 and a telephone 158.

Williams relates to a bedside control unit for a hospital bed. Williams describes a hospital bed 10 including siderails 14 and a control module 40 supported above the hospital bed by an articulating arm structure 20 that allows freedom of movement in all planes. A control panel 52 is mounted to the control module 40 and includes a plurality of membranes switches which are actuated by an associated push button.

Applicants submit that the Examiner has improperly rejected independent claim 38 under 35 U.S.C. § 103(a) using a combination of Marra and Williams and also a combination of Mitchell and Williams. Both of these combinations are improper because Williams specifically teaches away from providing a bed controller on or in a bed siderail.

"One inherent problem with current side rail controls or pendant speaker systems is that confused or challenged patients have a great deal of difficulty locating and manipulating the controls. For example, pendant speaker systems are not

mounted in a fixed location and can be lost in the bed clothes. In the case of side rail controls, they are frequently mounted in locations which are not convenient or conducive to their use.

Another disadvantage of side-rail controls and pendant speaker systems is that they are generally accessible to the patient only when the patient is in the hospital bed. After surgery or other treatment, it is generally desirable to ambulate the patient as soon as is medically practicable. Studies show that ambulating patients as quickly as possible after surgical procedures decreases the patient's recovery time and also the overnight stays required. Patients are therefore encouraged to sit upright in a bedside chair in the patient's hospital room rather than remain confined in the hospital bed. Current pendant systems and side rail controllers are frequently inaccessible to the patient once the patient is out of the hospital bed.

Current side rail control systems are also inaccessible to the visiting family member who might be staying with the patient during recovery. The existing T.V. controls and other environmental controls are not accessible to the visitor when they are fixed to the bed side rail." (See Williams, col. 1, lines 20-45) (emphasis added).

For the U.S. Patent and Trademark Office to "establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." Manual of Patent Examining Procedure (M.P.E.P.) Section 2143.

It is well known that when combining the content of various references "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Raynes*, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Moreover, the Patent and Trademark Office can satisfy its burden of establishing obviousness "only by showing some *objective* teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teachings of the references." *In re Fine*, 1837 F.2d 1071, 1073, 5 USPQ2d 1596

(Fed. Cir. 1988) (emphasis added) (citations omitted). The Federal Circuit in *In re Fine* stated that a “bald assertion” of substituting an element in a prior art reference would have been within the ordinary skill in the art is insufficient to support a finding of obviousness.” *Id.* at 1074.

The Federal Circuit has emphasized the requirement that the prior art must suggest the modifications necessary to achieve the claimed invention. The “mere possibility” that a prior art reference could be modified such that its use would lead to the particular result recited in a claim does not make that recited in the claim obvious “unless the prior art suggested the desirability of such a modification.” *In re Ochia*, 71 F.3d 1565, 1570, 37 USPQ2d 1127 (Fed. Cir. 1995). “Obviousness cannot be established by hindsight combination to produce the claimed invention.” *In re Dance*, 48 USPQ2d at 1637; *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

The Examiner cannot combine the microprocessor and display of Williams with the siderail controls of Marra or Mitchell because Williams specifically teaches away from using siderail bed controls. There is a complete lack of motivation to combine the references. One of ordinary skill in the art would certainly not be compelled to combine Williams with Marra or Mitchell in view of Williams teaching away from such combination. Therefore, withdrawal of the rejections to claim 38 is respectfully requested. Claims 40-44 and 65-69 depend either directly or indirectly from properly allowable claim 38 and contain independently patentable subject matter. Withdrawal of the rejections to claims 40-44 and 65-69 is also respectfully requested.

#### **Allowed Claims**

Applicants acknowledge with appreciation that claims 27, 29-37, 39, 45-47, 58-64 and 70 have been allowed by the Examiner. Claim 45 has been amended to correct a minor typographical error.

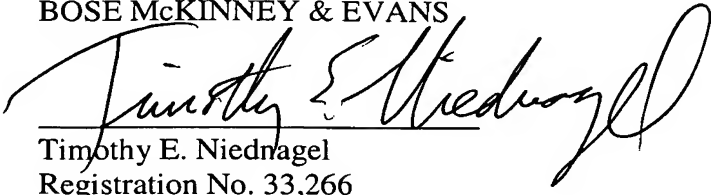
#### **Final Remarks**

Applicants submit that claims 27, 29-47, and 58-70 are in condition for allowance. Such allowance is respectfully requested.

If necessary, Applicants request that this Amendment be considered a request for an extension of time for a time appropriate for the response to be timely filed. Applicants request that any required fees for filing this Amendment be charged to the account of Bose McKinney & Evans LLP, Deposit Account Number 02-3223.

Respectfully submitted,

BOSE McKINNEY & EVANS

A handwritten signature in black ink, appearing to read "Timothy E. Niednagel", written over a horizontal line.

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